

REMARKS

Claims 1-21 are pending in the application.

Claims 1-21 have been rejected.

The Examiner is thanked for noting the incorrect dependency reference of claims 5-9; these have been corrected. The claim objections are obviated.

Reconsideration of the claims is respectfully requested.

I. CLAIM REJECTION UNDER 35 U.S.C. § 103

Claims 1-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,947,989 to *Gullotta, et al.*, hereinafter “Gullotta”. The Applicants respectfully traverse the rejection.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a *prima facie* case of obviousness. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984)). It is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. (*Id.* at 1073, 5 USPQ2d at 1598). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide “some articulated reasoning with some

rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. MPEP § 2142, p. 2100-125 (8th ed. rev. 5, August 2006). To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *Id.*

Claim 1 requires a number of specific components. The Examiner makes no attempt at all to show these specific components as taught or suggested by the art of record, and so fails to make a *prima facie* rejection. While applicant of course always considers references as a whole, this does not relieve the Examiner of his burden to actually show the teachings of the limitations in the cited art.

Claim 1 requires an order services management component. Gullotta mentions an RPM system may provision a user with "soft" resources, potentially including non-traditional "soft"

resources that may include the capability to order products over the Internet. This only describes ordering products, not services.

Claim 1 also requires a services fulfillment management component. Gullotta describes user applications that may also include a Policy Management application that provides an interface for defining policies that control the provisioning of services to users.

Claim 1 also requires an assurance management component. Nothing in Gullotta teaches or suggests a user management component.

Claim 1 also requires a financial management component. Gullotta describes that a managed service can include financial services, but not a financial management component in particular.

Claim 1 also requires a business analytics management component. This is not taught or suggested at all by Gullotta.

Finally, claim 1 requires that all those components be simultaneously available to a user. Even if some of the other claim limitations were found in Gullotta, they are not taught to be simultaneously available to a user.

The rejection of claims 1-3 are traversed.

The remaining independent claims similarly require a number of features. The Examiner makes no attempt at all to show these specific features as taught or suggested by the art of record, and so fails to make a *prima facie* rejection.

Claim 4 requires several limitations regarding a resource inventory, including checking a resource inventory to determine if a system resource that corresponds to the system resource is available to the user, assigning a system resource from the inventory to the user, and updating the resource inventory to indicate that the system resource was assigned to the user.

Gullotta does not teach or suggest an inventory at all. The “RPM system” tracks resources assigned to a user, evidently to be sure that all suitable resources are assigned to the user, but does not function as an inventory (instead, it appears to function more as a checklist). Gullotta clearly cannot teach or suggest the limitations of Claim 4, or similar limitation of claims 10 and 16.

Accordingly, the Applicants respectfully request the Examiner to withdraw the § 103 rejection with respect to these claims.

All rejections are traversed. Other distinctions exists, but the above clearly shows that all claims distinguish over Gullotta.

CONCLUSION

As a result of the foregoing, the Applicants assert that the remaining claims in the Application are in condition for allowance, and respectfully requests that this Application be passed to issue.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *manderson@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 05-0765.

Respectfully submitted,

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